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| 09/879,235 | 06/11/2001 | Lawrence A. Jenkins | 81896 | 3699 |
| 23409 | 7590 | 09/15/2004 | EXAMINER | |
| MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202 | | | ELISCA, PIERRE E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,235

Applicant(s)

JENKINS, LAWRENCE A.

Examiner

Pierre E. Elisca

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[Handwritten signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10 and 39-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10 and 39-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to Applicant's amendment, filed on 06/14/2004.
2. Claims 1, 4-10 and 39-47 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 7-10 and 39-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al. (U.S. Pat. No. 5,946,660) and Joao (U.S. pat. No. 6,347,302) in view of Denny et al. (U.S. pat. No. 5,724,261).

As per claims 1, 7-10 and 39-47 McCarty substantially discloses an automated storage system comprising a plurality of self-storage facilities, wherein a customer may rent from available storage units for the purpose of safeguarding various articles for a given period of time (which is equivalent to Applicant's claimed invention wherein it is stated that a method for renting to a customer a self-storage unit located at a self-storage facility), the method comprising the steps of:

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providing a customer service area including a customer service counter, the customer service counter having a rental agreement viewing area which is viewed by at least one camera positioned in the customer service area, the customer service counter being configured to minimize glare in images captured by the at least one camera (see., abstract, col 1, lines 5-16, specifically wherein it is stated that self-storage facilities, wherein a customer may rent from available storage units, please note that McCarty discloses a **video capture means in the form of a camera 32 see., fig 3, col 5, lines 1-18**);

establishing voice communication between a remote manager and a customer entering the customer service area so that the customer and manager can communicate using a communication link (see., col 3, lines 1-16, lines 31-44, specifically wherein it is stated that communicatively linking a plurality of self-storage facilities or customer to a central processing center or remote manager, and also col 3, lines 18-31, col 4, lines 15-51, it is obvious to realize that the communication link of McCarty can also includes voice communication or direct communication between the customer and the remote manager since customer always communicates orally with the store's manager);

the customer orally communicating to the remote manager through the communication link an indication of the customers storage needs (see., col 3, lines 18-31, specifically wherein it is stated that the external access system allows a user to communicate with the central processing center to conduct a plurality of automated rental transactions including renting from any of the plurality of storage units within the plurality of storage facilities. **Applicant should duly note that the process of a user or customer**

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conducting a plurality of automated rental transaction also includes indicating of customer storage needs. The Examiner asserts that whenever a customer enters a store or company's store front, it is always good for customer service to have the customer communicates ORALLY with someone at the store in order to provide good customer service and or relationship with the customer. Also, the Examiner asserts that mostly, there is an attendant or manager present at a storage facility in order to help the potential customers in providing them with the desired type of services, such as verifying at least some of data. In filing out a form or rental agreement, the customer must provide certain information or must sign in their name as would have been requested by the manager so as to confirm a contract agreement between the customer and the storage facility);

the remote manager orally communicating to the customer through the communication link a recommended self-storage unit (see., col 7, lines 61-67, col 8, lines 1-45, specifically wherein it is stated after completing the input of rental information, the user must then select from a variety of payment methods such as credit card payment, check payment. Once payment method has been verified, the processor within the kiosk will then generate a custom rental agreement based on the personal rental information, please note that this step is equivalent to a payment information or credit information process about a customer or user);

the remote manager facilitating inspection of the recommended self-storage unit by the customer, the step of the remote manager facilitating inspection of the recommended self-storage unit including the step of providing the customer access to the

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recommended self-storage unit so the customer can inspect the recommended self-storage unit (see., col 5, lines 50-67, col 8, lines 24-45, specifically wherein it is stated that rental agreement has been generated, the rental agreement is then displayed on the screen display to allow user or customer to review the proposed agreement on hardcopy). Furthermore, McCarty discloses a telephone communication link see., fig 3, item 42, and therefore, it is obvious to realize that the telephone communication link of McCarty can telephone customers or manager when a customer service area door is activated or when a customer entering service area, or picks up a telephone since telephone communication link is a common telecommunication practice. McCarty also discloses an access gate to said one or more self-storage units (see., fig 2, item 24), and viewing the customer approaches access gate see., fig 2, items 30, 28 and 22, col 5, lines 1-15);

providing the customer a hardcopy rental agreement (see., col 5, lines 50-67, col 8, lines 24-45, specifically wherein it is stated that rental agreement has been generated, the rental agreement is then displayed on the screen display to allow user or customer to review the proposed agreement on hardcopy);

the remote manager directing the customer to fill out portions of the hardcopy rental agreement form the customer inserting certain data on the hardcopy rental agreement form as directed by the remote manager (see., col 5, lines 50-67, col 8, lines 24-45, specifically wherein it is stated that rental agreement has been generated, the rental agreement is then displayed on the screen display to allow user or customer to review the proposed agreement on hardcopy. **The Examiner asserts that mostly, there is an**

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attendant or manager present at a storage facility in order to help the potential customers in providing them with the desired type of services, such as verifying at least some of data. In filing out a form or rental agreement, the customer must provide certain information or must sign in their name as would have been requested by the manager so as to confirm a contract agreement between the customer and the storage facility).

It is to be noted that McCarty fails to explicitly disclose the step of communicating a recommended self-storage unit to the customer from the remote manager. Joao discloses a rented articles such as personal, residential as well as commercial property leases and rentals. For protecting individuals and/or business entities, lease and/or rental from liability, recommendation by an insurer or remote manager in determining whether to issue a policy, product, service, please note that the product also includes lease or rental, and therefore, recommending rental or self-storage unit to the user (see., col 1, lines 15-21, col 2, lines 7-18, col 8, lines 34-39). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was to made to modify the automated storage system of McCarty by including a recommendation to the customer from the manager or insurer as taught by Joao because such modification would provide transactions with potential customers and recommending available storage units.

McCarty and Joao fail to explicitly disclose the step of facilitating inspection of the recommended self-storage unit by the customer. However, Denny discloses a data processing that includes a property inspection (property or rental article) see., abstract,

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col 2, lines 9-26 and lines 47-67. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of McCarty and Joao by incorporating the limitation detailed above as taught by Denny because such modification would provide protection against liability which may arise as a result of wear and tear.

6. Claims 4, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al. (U.S. Pat. No. 5,946,660), Joao (U.S. pat. No. 6,347,302) and Denny et al. (U.S. pat. No. 5,724,261), and further in view of Official notice.

As per claims 4, 5 and 6 McCarty, Joao, and Denny disclose the claimed limitations as stated in claim 1 above, including a telephone, internet or web or email, video connection or video means see., McCarty col 4, lines 41-43, col 5, lines 9 and 10, col 6, line 34. It is obvious to realize that the telephone communication link of McCarty can telephone customers or manager when a customer service area door is activated or when a customer entering service area, or picks up a telephone since telephone communication link is a common telecommunication practice. It is to be noted that McCarty, Joao, and Denny fail to explicitly disclose a radio, cellular, satellite, and facsimile communication links. However, the Examiner hereby takes Official notice that radio, cellular, satellite, and facsimile communication links are notoriously well-known in the art, and therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the limitations detailed above since they are conventional communication means.

RESPONSE TO ARGUMENT

7. Applicant's arguments filed on 06/14/2004 have been fully considered but they are not persuasive.

REMARKS

8. In response to Applicant's argument, Applicant argues that neither McCarty nor Joao and Denny alone or in combination do not teach:

a. Applicant also maintains that McCarty, Joao and Denny cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilli & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly

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suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. " a customer orally communicates with a remote manager while the customer is positioned in a customer service area. Based upon foregoing rejection indicated above, it is believed that McCarty discloses this limitation in the abstract, col 1, lines 5-16, specifically wherein it is stated that self-storage facilities, wherein a customer may rent from available storage units, please note that McCarty discloses a video capture means in the form of a camera 32 see., fig 3, col 5, lines 1-18.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Pierre Eddy Elisca

Primary patent examiner

September 08, 2004